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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/898,853	07/25/1997	HISASHI YAMAGISHI	Q45980	6473

7590 11/06/2006

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WASHINGTON, DC 200373202

EXAMINER

TRIMIEW, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Applicant has suggested an interference pursuant to 37 CFR 41.202(a) in a communication filed 4-21-06.

Applicant failed to provide sufficient information to identify the application or patent with which the applicant seeks an interference. See 37 CFR 41.202(a)(1) and MPEP § 2304.02(a).

COUNTS: Under the heading of 37 CFR 41.202 (a)(2), (page 2 of the renewed request for interference) applicant proposes the count as: "A golf ball according to any one of claims 1 – 7 of the Ohsumi Patent" or alternatively "a golf ball according to any of claims 13 – 19 of the Yamagishi application." Neither of these statements properly defines a count for interference. Looking to 37 CFR 41.201, by definition a count is "the Board's description of the interfering subject matter that sets the scope of admissible proofs on priority. Where there is more than one count, each count must describe a patentably distinct invention". A count may also be viewed as the broadest patentable subject matter that is in conflict between parties. If applicant is proposing that each claim defines a separate count, then such should be set forth with an explanation of how the counts define patentably distinct inventions over each other count. Alternatively, applicant should choose the broadest patentable claim between the two parties and designate it as being equivalent to the count. See MPEP Chapter 2300.

CLAIM CORRESPONDENCE: Applicant has failed to establish his position as to which claims he believes correspond to the count. Claims do not correspond to the count because they have been copied from another source. Claims do not correspond to the count because they are dependent from a claim which is equivalent to the count. A

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claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim.

Thus, correspondence to a count is based upon the subject matter of the claim and the state of the prior art. For example, if a proposed count is identical to claim 13 of the instant application, claim 13 would correspond to the count because if the count were viewed as prior art, the count would anticipate the claim. Similarly, if a proposed count is identical to claim 13 of the instant application, claim 14 of the application would be designated as correspond to the count because the difference between claim 14 in the count is that the count fails to set forth the particular claimed range of shore D hardness and providing an inner layer having a shore D hardness in the range of 20 – 40 is known in the prior art. Thus claim 14 would correspond to the count because it is an obvious variant of the count. If this range was not know/not obvious then potentially claim 14 defines a second count. Accordingly, applicant should indicate in their request which claims do or do not correspond to the count because the claims are anticipated by or obvious variants of the subject matter of the count.

37 CFR 41.202 (a)(6) Applicant's suggestion for interference under 37 CFR 41.202 (a) fails to comply with paragraph (a) (6) in providing a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter for each constructive reduction to practice for which applicant wishes to be accorded benefit. As is outlined in MPEP 2304.02(c), "If the application is relying on a chain of benefit disclosures under any of 35 USC 119, 120, 121 and 365, the anticipating disclosure must be continuously disclosed through the entire benefit chain

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or no benefit may be accorded.” Here, applicant has shown where the subject matter is contained within the present application and within the earliest priority document.

Applicant must show, in his chart, all applications within the chain of priority in order to ensure the subject matter has been continuously disclosed through the entire benefit chain. Applicant should add parent file 08/661778 to the chart.

Applicant should note that the requirements of 37 CFR 41.202 (a)(2) – (6) are interrelated and depend upon the definition of a count. While it is possible to supplement the request previously filed, changing the definition of the count may impact some or all of the remaining paragraphs and applicant may alternatively submit a new request for interference.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to correct the deficiency(ies). THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on Mon, Wed, Fri 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rg
October 28, 2006



RAEANN GORDEN
PRIMARY EXAMINER